

Amendment and Response under 37 C.F.R. 1.116
Applicant: Stuart Asawaka
Serial No.: 09/905,623
Filed: July 13, 2001
Docket No.: 10011919-1
Title: PRINT FOR PAY PRINTER

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REMARKS

The following remarks are made in response to the Final Office Action mailed May 1, 2007, in which claims 1-20 were rejected. With this Response, no claims have been amended. Claims 1-20 remain pending in the application and are presented for reconsideration and allowance.

Claim Rejections under 35 U.S.C. § 103

Claims 1, 3, 4, 9-11, 15 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Robinson, et al., U.S. Patent No. 5,850,584 ("Robinson") in view of Keane, et al., U.S. Patent No. 6,650,433 ("Keane").

Regarding independent claims 1, 9, and 19, the Office Action alleges Robinson substantially discloses the claimed subject matter, except that Robinson does not specifically teach that a charge is calculated only as a function of the enhanced printer operational resource request. Keane is cited to overcome the deficiency of Robinson, disclosing that business cards are offered to customers by a web server host at no charge, and the cost of printing these items can be recouped by the web server host by charging a fee of upgrades. Specifically, Keane discloses that the web server host may include an advertisement on the back of each free business card, and charge a fee if the customer does not wish the advertisement to appear on the customer's card. The Office Action concludes it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Keane to the teachings of Robinson because such modification provides a cheaper rate for the customers to print a standard print without losing profitability of the printing company.

Applicant respectfully submit that the combination of Robinson and Keane cannot support a case of prima facie obviousness as to the claims because, among other possible reasons, the references, alone and in combination, fail to disclose or make reasonably obvious all of the features of the present invention.

Independent claims 1 and 19 set forth that the printer operational resources comprise *core* printer operational resources and *enhanced* printer operational resources, and specify, in part, that the payment transaction includes a charge calculated *only* as a function of the *enhanced* printer operational resource request. Independent claim 9 similarly divides

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Applicant: Stuart Asawaka

Serial No.: 09/905,623

Filed: July 13, 2001

Docket No.: 10011919-1

Title: PRINT FOR PAY PRINTER

printer operational resources into a *first* resource set (e.g., a core resource set) and a *second* resource set (e.g., an enhanced resource set), and specifies that a **payment transaction is initiated *only* when the requested printer operational resource is a member of said *second* set.**

The specification of the instant application describes that printer operational resources are divided into layers to stratify price levels, and "core" resources contain "the basic printer resources needed to print standard output." (Page 6, lines 29-31). Printer resources outside of the "core" resources are considered "enhanced" printer operational resources. As set forth above, the Office Action acknowledges that Robinson does not teach that a charge is calculated only as a function of the enhanced printer operational resource request. Applicant respectfully submits, contrary to the characterization set forth in the Office Action, Keane also fails to teach or make reasonably obvious that that a charge is calculated only as a function of an enhanced printer operational resource request.

The portion of Keane referenced in the Office Action states:

"In some implementations, relatively low cost items, e.g., business cards are offered to customers by the web server host at no charge. The cost of printing these items can be recouped by the web server host by charging a fee for upgrades, e.g., faster delivery, and sales of complimentary items such as business card cases. For example, as discussed above, the web server host may include an advertisement (e.g., "Free Business Cards at vistaprint.com") on the back of each free card, and charge a fee if the customer does not wish the advertisement to appear on the customer's card."

(Keane, col. 14, lines 39-49)

As clearly seen from the above-quoted portion of Keane, the reference does not teach or make reasonably obvious that that a charge is calculated *only* as a function of an enhanced printer operational resource request, as set forth in independent claims 1, 9 and 19. Rather the specifically listed "upgrades" of Keane for which a charge is assessed include "faster delivery," which is clearly not a printer operational resource of any type. Regarding the option for a customer to pay a fee to avoid the printing of an advertisement on the customer's business cards, Applicant submits *a failure to print does not constitute use of an "enhanced" printer operational resource, as by definition "core" printer resources are used to print the standard, i.e., free, output, and no different or additional printer*

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Docket No.: 10011919-1

Title: PRINT FOR PAY PRINTER

resources beyond the core printer resources are used when *not printing* the advertisement.

For at least the reasons set forth above, the combination of Robinson and Keane does not teach or make reasonably obvious every feature of independent claims 1, 9 and 19. Based on the foregoing, Applicant submits that the combination of Robinson and Keane cannot support a 35 U.S.C. 103(a) rejection of independent claims 1, 9 and 19, and respectfully requests that the rejection be withdrawn.

Each of dependent claims 3, 4, 10-11 and 15 depend from one of independent claims 1 and 9, which are in allowable condition for at least the reasons set forth above. Therefore, dependent claims 3, 4, 10-11 and 15 are also believed in allowable condition at least by reason of their dependency from an allowable claim. For at least the reasons provided above, Robinson and Keane cannot support a 35 U.S.C. 103(a) rejection of claims 3, 4, 10-11 and 15, and withdrawal of the rejection is respectfully requested.

Claims 2 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Robinson in view of Keane as applied to claims 1 and 9 above, further in view of Pierce, U.S. Patent No. 6,202,0257.

Dependent claims 2 and 13 depend from independent claims 1 and 9, respectively. As set forth above, the combination of Robinson and Keane fails to disclose all of the elements of independent claims 1 and 9. Applicant respectfully submits Pierce fails to remedy the deficiencies of the combination of Robinson and Keane, in that Pierce also fails to teach or suggest distinguishing between *core* printer operational resources (i.e., a first resource set) and *enhanced* printer operational resources (i.e., a second resource set), and further fails to teach or suggest a charge calculated *only* as a function of the request for the use or right of use of an enhanced printer operational resource (i.e., a resource of the second set).

Based on the foregoing, Applicant submits that the combination of Robinson, Keane, and Pierce cannot support a 35 U.S.C. 103(a) rejection and respectfully request that the rejection be withdrawn.

Amendment and Response under 37 C.F.R. 1.116

Applicant: Stuart Asawaka

Serial No.: 09/905,623

Filed: July 13, 2001

Docket No.: 10011919-1

Title: PRINT FOR PAY PRINTER

Claims 5 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Robinson in view of Keane as applied to claims 4 and 15 above, further in view of Maruta, et al., U.S. Patent No. 6,064,838.

Dependent claims 5 and 16 depend from independent claims 1 and 9, respectively. As set forth above, the combination of Robinson and Keane fails to disclose all of the elements of independent claims 1 and 9. Applicant respectfully submits Maruta fails to remedy the deficiencies of the combination of Robinson and Keane, in that Maruta also fails to teach or suggest distinguishing between *core* printer operational resources (i.e., a first resource set) and *enhanced* printer operational resources (i.e., a second resource set), and further fails to teach or suggest a charge calculated *only* as a function of the request for the use or right of use of an enhanced printer operational resource (i.e., a resource of the second set).

Based on the foregoing, Applicant submits that the combination of Robinson, Kean, and Maruta et al. cannot support a 35 U.S.C. 103(a) rejection and respectfully request that the rejection be withdrawn.

Claims 6 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Robinson in view of Keane as applied to claims 4 and 15 above, further in view of Hayashi, U.S. Patent No. 6,375,297.

Dependent claims 6 and 17 depend from independent claims 1 and 9, respectively. As set forth above, the combination of Robinson and Keane fails to disclose all of the elements of independent claims 1 and 9. Applicant respectfully submits Hayashi fails to remedy the deficiencies of the combination of Robinson and Keane, in that Hayashi also fails to teach or suggest distinguishing between *core* printer operational resources (i.e., a first resource set) and *enhanced* printer operational resources (i.e., a second resource set), and further fails to teach or suggest a charge calculated *only* as a function of the request for the use or right of use of an enhanced printer operational resource (i.e., a resource of the second set).

Based on the foregoing, Applicant submits that the combination of Robinson, Keane, and Hayashi cannot support a 35 U.S.C. 103(a) rejection and respectfully request that the rejection be withdrawn.

Amendment and Response under 37 C.F.R. 1.116

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Serial No.: 09/905,623

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Title: PRINT FOR PAY PRINTER

Claims 7, 8, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Robinson in view of Keane as applied to claims 1 and 15 above, further in view of Nocker, U.S. Patent No. 6,236,486.

Dependent claims 7, 8 and 18 depend from independent claims 1 and 9, respectively. As set forth above, the combination of Robinson and Keane fails to disclose all of the elements of independent claims 1 and 9. Applicant respectfully submits Nocker fails to remedy the deficiencies of the combination of Robinson and Keane, in that Nocker also fails to teach or suggest distinguishing between *core* printer operational resources (i.e., a first resource set) and *enhanced* printer operational resources (i.e., a second resource set), and further fails to teach or suggest a charge calculated *only* as a function of the request for the use or right of use of an enhanced printer operational resource (i.e., a resource of the second set).

Based on the foregoing, Applicant submits that the combination of Robinson, Keane, and Nocker cannot support a 35 U.S.C. 103(a) rejection and respectfully requests that the rejection be withdrawn.

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Robinson in view of Keane as applied to claim 9 above, further in view of Sugiura, et al., U.S. Patent No. 4,393,375.

Dependent claim 12 depends from independent claim 9. As set forth above, the combination of Robinson and Keane fails to disclose all of the elements of independent claims 9. Applicant respectfully submits Sugiura fails to remedy the noted deficiencies of the combination of Robinson and Keane, in that Sugiura at least fails to teach or suggest that a charge calculated *only* as a function of the request for the use or right of use of an enhanced printer operational resource.

Based on the foregoing, Applicant submits that the combination of Robinson, Keane, and Freeman cannot support a 35 U.S.C. 103(a) rejection and respectfully requests that the rejection be withdrawn.

Amendment and Response under 37 C.F.R. 1.116

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Serial No.: 09/905,623

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Docket No.: 10011919-1

Title: PRINT FOR PAY PRINTER

Claims 14 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Robinson in view of Keane as applied to claims 9 and 19 above, further in view of Freeman, U.S. Patent No. 6,134,557.

Dependent claims 14 and 20 depend from independent claims 9 and 19, respectively. As set forth above, the combination of Robinson and Keane fails to disclose all of the elements of independent claims 9 and 19. Applicant respectfully submits Freeman fails to remedy the deficiencies of the combination of Robinson and Keane, in that Freeman also fails to teach or suggest distinguishing between *core* printer operational resources and *enhanced* printer operational resources, and further fails to teach or suggest a charge calculated *only* as a function of the request for the use or right of use of an enhanced printer operational resource.

Based on the foregoing, Applicant submits that the combination of Robinson, Keane, and Freeman cannot support a 35 U.S.C. 103(a) rejection and respectfully requests that the rejection be withdrawn.

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Amendment and Response under 37 C.F.R. 1.116
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CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-20 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-20 is respectfully requested.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application. Any inquiry regarding this Amendment and Response should be directed to either Matthew B. McNutt at Telephone No. (612) 767-2510, Facsimile No. (612) 573-2005 or Nathan R. Rieth at Telephone No. (208) 396-5287, Facsimile No. (208) 396-3958. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

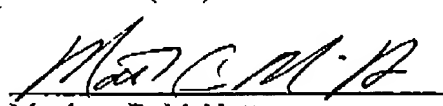
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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being transmitted via facsimile to Facsimile No. (571) 273-8300 on this 29th day of June, 2007.

By: 

Name: Matthew B. McNutt